REMARKS

Applicants thank the Examiner for the detailed Office Action dated October 18, 2004. Applicants respectfully request reconsideration of the present application in view of the reasons that follow.

Claims 1-42 remain pending in the application.

Drawings

Please substitute the attached five sheets of formal drawings for the informal drawings originally filed with the application.

Claim Rejections – 35 U.S.C. § 103(a)

On page 2 of the Office Action, claims 1-42 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,577,090 ("Brown") in view of U.S. Patent No. 5,497,326 ("Berland et al.") and U.S. Patent No. 5,591,100 ("Hayashi et al."). Applicants respectfully traverse the rejection. None of the cited references, alone or in combination, disclose, teach, or suggest Applicants' invention as claimed.

Claims 1, 11, 19, 28 and 35 are in independent form. Claims 2-10 depend from independent claim 1. Claims 12-18 depend from independent claim 11. Claims 20-27 depend from independent claim 28. Claims 36-42 depend from independent claim 35.

Brown relates to an "apparatus for producing a floating DC voltage source from an electric motor." Berland et al. relates to a "control system for use with a bidirectional motor connected to a motorized vehicle accessory to move the accessory a distance from a first position to a second position." Hayashi et al. relates to a "continuously variable transmission vehicle."

The PTO acknowledges the standard that in order to establish a prima facie case of obviousness, the following criteria must be met: (1) **there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available**

to one of ordinary skill in the art, to modify the reference or to combine reference teachings, (2) there must be a reasonable expectation of success, and (3) the cited references must teach or suggest all the claim limitations. (See MPEP § 2143.)

The Federal Circuit has further explained that

> A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher."
>
> Most if not all inventions arise from a combination of old elements. Thus, every element of a claimed invention may often be found in the prior art. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. **Rather to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant.**

In re Kotzab, 217 F.3d 1365, 1369-70 (Fed. Cir. 2000) (citations omitted).

Applicants respectfully submit that there is no motivation, teaching, or suggestion to combine Brown with Berland et al. and/or Hayashi et al. to provide the subject matter recited in independent claims 1, 11, 19, 28, and 35. The motivation provided in the Office Action – to achieve positional accuracy and integral motor and sensor for improved space control – is legally insufficient. Applicants have been unable to locate any teaching that the use of Brown with Berland et al., and/or Hayashi et al. would result in a motor having greater positional accuracy and improved space control. Furthermore, there is not other motivation, teaching, or suggestion to combine the cited references.

The subject matter recited in independent claims 1, 11, 19, 28, and 35 and the claims which are dependent thereon, considered as a whole, would not have been obvious to a person having ordinary skill in the art and are patentable. Accordingly, the Applicants request withdrawal of the rejection of claims 1-42 under 35 U.S.C. § 103(a).

* * *

Double Patenting

On page 2 of the Office Action, claims 1-42 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-30 of copending U.S. Application No. 10/651,749. Applicants will respond to this rejection once Applicants receive an indication that the claims in this application or in Application No. 10/651,749 are allowable.

* * *

Applicants respectfully submit that each and every outstanding objection and rejection has been overcome, and the present Application is in a condition for allowance. The Applicants request reconsideration and allowance of the pending claims.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 06-1447. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 06-1447.

Respectfully submitted,

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